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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,868	08/05/2003	Scott T. Ginkel	58892US002	9021
32692	7590	06/07/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				DESAI, ANISH P
ART UNIT		PAPER NUMBER		
1771				

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/635,868	GINKEL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Anish Desai	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 5th August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/28/05&amp;08/05/03</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-14 (Group I) drawn towards a mailer in the reply filed on May 16<sup>th</sup> 2005 is acknowledged. The applicant argues that the traversal is on the ground(s) that the Groups I and II claims are interrelated and the classification of claims of Group I and Group II (claims 15-17) in different classes and subclasses is not sufficient grounds to require restriction.
2. This is not found persuasive because the invention of Group I and Group II are distinct. The claimed invention is classified into two separate classes and sub classes that are distinct from each other. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, it puts burden on the examiner to search for the prior art into two separate art areas.
3. The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Applicant claims "the mailer of claim 1 wherein the form substrate is a roll-good". It is not clear as to what does the applicant means by "good". The examiner is interpreting "roll-good" as any form substrate that is capable of being rolled.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rajan et al. (US Patent 6,406,787) in view of Peterson et al. (US Patent 6,092,843).
7. Rajan et al. teach a novel form construction comprising a form sheet having a digital printable surface portion and a release surface portion, on which release coating surface portion a signage with a pressure sensitive adhesive can be releasably adhered. A digital printable release coating composition is also provided (see Abstract). In a preferred embodiment a digital printable release coating is provided on the surface of the form sheet. In this case, the release coating may be provided on the entire surface of one side of the form sheet and a signage maybe applied anywhere on the form sheet so that handling of a form sheet with a signage is easy (Column 4, lines 53-59). The examiner is equating signage of Rajan et al. as a sticker as claimed in claim 2.
8. According to Rajan et al. the signage article has a substrate and a marking material in addition to a pressure sensitive adhesive. The substrate has an organic polymeric surface (Column 15, lines 32-35). The examiner is equating the substrate of Rajan et al. as a backing as claimed in claim 2. The polymeric surface of Rajan et al. meets the limitation of polymeric film as claimed in claim 3. In a preferred embodiment,

the substrate of a signage article is retroreflective sheeting (Column 15, lines 48-49)

which meets the claimed limitations of retroreflective backing as claimed in claim 4.

9. The examples of signage include validation stickers, indoor/outdoor labeling products, product authentication articles, inventory labeling and control articles, window stickers and inspection stickers for automobiles and other equipment, parking permits, expiration stickers etc (Column 4, lines 13-17). These examples meet the limitations of validation stickers and parking permit stickers as claimed in claim 5.

10. According to Rajan et al. the validation stickers may have one or more security openings which provide tear and shredding sites for the stickers, thereby making them "frangible" (Column 16, lines 8-14). The examiner is equating security openings as tamper indicating feature as claimed in claim 6.

11. The form substrate in the invention of Rajan et al. is preferably a paper (Column 4, lines 19-20). Although, Rajan et al. do not explicitly teach that the form substrate is a roll-good as claimed in claim 7, it is obvious that a sheet of paper is capable of being rolled.

12. Regarding claim 9, as disclosed above, Rajan et al. disclose a form sheet.

13. Rajan et al. are silent with respect to teaching that the adhesive is disposed on the form sheet such that form may be folded and self-sealed as claimed in claim 1. Additionally, Rajan et al. are silent with respect to teaching perforations as claimed in claim 8.

14. Peterson et al. disclose a license plate decal, which is provided on a folded business form that acts as a carrier for the decal (see Abstract). Additionally Peterson

et al. disclose adhesive means disposed on the form. These adhesive means hold the intermediate in a mailer configuration when the paper sheet is folded (Column 2, lines 59-64). These adhesive means are shown in Figure 5 and Figure 6 (Column 6, lines 47-50). Additionally, Peterson et al. disclose an intermediate (i.e. mailer type business form intermediate) with fold lines, which may be score lines, perforation lines, or any other suitable lines which facilitate folding (and perhaps detachment) (Column 5, lines 60-64).

15. Regarding claim 1, the inventions of Rajan et al. and Peterson et al. are disclosed above. A skilled artisan would have found it obvious to use adhesive means disclosed in the invention of Peterson et al. and disposed it on the form sheet of Rajan et al. One would be motivated to do this so that the form sheet can be securely folded and sealed.

16. Regarding claim 8, the inventions of Rajan et al. and Peterson et al. are disclosed above. A skilled artisan would have found it obvious to use perforations disclosed in the invention of Peterson et al. and used it in the form substrate of Rajan et al. One would be motivated to do this in order to provide a form substrate so that it can be detached easily when it is in the rolled configuration.

17. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rajan et al. (US Patent 6,406,787) in view of Peterson et al. (US Patent 6,092,843).

18. Regarding claim 10, the inventions of Rajan et al. and Peterson et al. are disclosed above. A skilled artisan would have found it obvious to use adhesive means

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disclosed in the invention of Peterson et al. and disposed it on the form sheet of Rajan et al. One would be motivated to do this so that the form sheet of Rajan et al. can be securely folded and sealed. Note that the examiner is equating form sheet of Rajan et al. as claimed form in claim 10.

19. Regarding claim 11, the inventions of Rajan et al. and Peterson et al. are disclosed above.

20. Regarding claim 12, the inventions of Rajan et al. and Peterson et al. are disclosed above. As stated previously, the release coating is provided on the entire surface of the form sheet and it is digital printable. Rajan et al. disclose a certificate of vehicle registration in as an example of form sheet in Figure 1 (Column 5, lines 37-38). Rajan et al. teach that Indicia can be in the form of alphanumeric characters. Thus, the writing such as the "CERTIFICATE OF VEHICLE REGISTRATION" in Figure 1 is considered as indicia.

21. Regarding claims 13 and 14, the inventions of Rajan et al. and Peterson et al. are disclosed above. In addition to above disclosed matters of the invention of Rajan et al., the signage surface (Column 5, lines 16-17) and the release coating are digital printable (see Abstract). Rajan et al. defines "digital printable" means printable by a digital printing including, not limited to, laser, ink-jet, thermal mass transfer, thermal dye transfer, electrostatic, ion deposition, electron beam imaging, solid ink-jet an dot-matrix printings (Column 5, lines 64-67, Column 6, line 1). Thus the digital printable means of Rajan et al. meet the limitations of claims 13 and 14.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER